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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,130	07/27/2000	JOHANN ENGELHARDT	293.000193	5635

7590 04/09/2002
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EXAMINER
SHAFFER, RICKY D

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/60/130

Applicant(s)

ENGELHARDT ET AL

Examiner

RO SHAFER

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11/15/01

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 13-30

is/are pending in the application.

Of the above claim(s) 21-30

is/are withdrawn from consideration.

☐ Claim(s)

is/are allowed.

☒ Claim(s) 13-20

is/are rejected.

☐ Claim(s)

is/are objected to.

☐ Claim(s)

are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

Part of Paper No. 8

Art Unit: 2872

1. Applicant's election without traverse of Invention I (claims 14-20) in Paper No. 7 is acknowledged.

2. Claims 21-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 7.

In view of applicant's remarks that the geometric configuration of a triangular passageway and a four-cornered (rectangular) passageway are obvious variants the species requirement set forth in Paper No. 6 is withdrawn.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13, 14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao ('247).

Xiao discloses an optical arrangement for spectrally fanning out an incoming beam (82) from an object (70) in a detection beam path (84) of a confocal microscope for subsequent splitting by mirrors (42, 43) of the spectrally fanned beam out of its dispersion plane and for detection (21, 22) of the split spectral range, wherein said incoming beam is focused by lens (34)

on a pinhole occluder (51) having a rectangular passageway. Note fig. 6 and column 4, lines 35 to 40, column 5, lines 44-49, column 6, lines 63 to column 7, line 5, column 7, line 61 to column 8, line 2 and column 8, lines 17-38.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao

('247) in view of applicant's admission that a triangular passageway is an obvious variant of a rectangular passageway or alternatively in view of Ebbesen et al ('316).

Ebbesen et al teaches it is known to use a triangular passageway configuration in the same field of endeavor of the purpose of enhancing light transmission.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the rectangular passageway of Xiao to include a triangular passageway as taught by Ebbesen et al et al or based on applicant's statement that such configurations would be obvious variants, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of one of ordinary skill in the art. Note In re Dailey et al, 149 USPQ 47.

7. Any inquiry concerning this communication should be directed to R. D. Shafer at telephone number (703) 308-4813.

Shafer/ds

03/26/02

Ricky D. Shafer
RICKY D. SHAFER
PATENT EXAMINER
ART UNIT 2872